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REMARKS

This paper is responsive to an Office Action mailed January 16, 2007. Prior to this response, claims 1-25 were pending. After amending claims 1-4, 7-9, 13-16, and 19-21, claims 1-25 remain pending.

Section 1 of the Office Action objects to informalities in claim 2. In response claim 2 has been amended to replace "a job output" with "the job output."

In Section 3 of the Office Action claim 1 has been rejected under 35 U.S.C. 112, second paragraph, as indefinite. In response, the claim has been amended as suggested by the Examiner.

In Section 5 of the Office Action claims 1-3, 10-11, 13-15, 22-23, and 25 have been rejected under 35 U.S.C. 102(b) as anticipated by Takimoto (US 6,202,092). With respect to claims 1 and 13, the Office Action states that Takimoto discloses a process of analyzing job attributes and controlling the job output in response to the attribute analysis, citing col. 1, ln. 12-40. This rejection is traversed as follows.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In col. 1 Takimoto describes a process for a security management system that initially determines if a user has the proper authority for a requested service, such as printing. Unlike the Takimoto invention, which initially identifies a user identify associated with a print request, the claimed invention analyzes attributes of the requested job. To

clarify the claimed invention, and definitely distinguish a job attribute from a user identity, claims 1 and 13 have been amended to recite that a job attribute is either associated with document content or a printer resource. Thus, while Takimoto discloses a job output controlled in response to user identity, the claimed invention uses a different control mechanism.

The Office Action has also rejected claims 3 and 15 stating that Takimoto discloses the analysis of the recited attributes. The Applicant acknowledges that col. 6, ln. 14-23, discloses the consideration of attributes such as color printing. However, Takimoto only discloses these attributes as "secondary" considerations, which are only considered after user identity is determined. As shown in Fig. 3b, attributes such as color printing are cross-referenced to user names. Alternately stated, Takimoto initially determines a user identity associated with a requested job, and then determines the particular printer services that may be accessed once the identity is known. This process is also described at col. 3, ln. 52-67. This 2-step process is different from the Applicant's one-step process of controlling job output in response to determining document content or requested printer resources.

Likewise, claims 2 and 14 have been amended to more definitely recite that when user identity is considered, that it is a "secondary" consideration. That is, the process initially determines the job attributes associated with the requested job. Then, the user identity is determined. Once the user identity is determined, a list of permitted job services is determined.

Takimoto does not disclose the limitation of controlling job output in response to initially determining the attributes of a requested job. Since Takimoto does not disclose this limitation, he cannot anticipate claims 1 and 13. Claims 2-3 and 10-11, dependent from claim 1, and claims 14-15,

22-23, and 25, dependent from claim 13, enjoy the same distinctions from the cited prior art reference, and the Applicant respectfully requests that the rejection be withdrawn.

Section 7 of the Office Action states that claims 4-6, 16-18, and 21 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Takimoto, in view of Kojima et al. ("Kojima"; US 6,807,388). With respect to claims 4 and 16, the Office Action acknowledges that Takimoto fails to disclose document content attributes, but that Kojima discloses such limitations, and that it would have been obvious to modify Takimoto to provide a data monitoring method that can freely select the allowance or inhibition of copying in accordance with secrecy management. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

The Takimoto and Kojima references have been combined on the assumption that Takimoto discloses all the limitations of claims 1 and 13. However, as noted above, Takimoto does not disclose the limitation of

initially analyzing job attributes (as defined in the amended claims), and controlling job output as a response to this analysis. Even if Kojima does disclose some document content attributes, there is no motivation in the Kojima reference to show that Takimoto can be modified to initially analyze attributes of the requested job. Further, no evidence has been provided that the source of such motivation comes from knowledge generally available at the time, and known by a person of skill in the art. For these reasons, the Applicant respectfully submits that a case has not been made to support the assumption that there is motivation to modify known art in such a way as to make obvious the claimed invention, which is the first *prima facie* requirement.

Likewise, no case has been provided to support the second *prima facie* requirement, that there is a reasonable expectation of success in the claimed invention.

With respect to the third *prima facie* requirement, even if the references are combined, they do not disclose all the elements of the claimed invention. As noted above, neither Kojima nor Takimoto disclose a system that initially analyzes the attributes of a requested job, as defined in amended claims 1 and 13, and controls job output as a result of the analysis. Claims 4-6, dependent from claim 1, and claims 16-18 and 21, dependent from claim 13, include the same distinctions as the base claims, and the Applicant requests that the rejection be removed.

In Section 8 of the Office Action claims 7 and 19 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Takimoto in view of Bauer et al. ("Bauer"; US 5,819,047). The Office Action acknowledges that Takimoto fails to describe quotas. This rejection is traversed as follows.

The Takimoto and Bauer references have been combined on the assumption that Takimoto discloses all the limitations of claims 1 and 13. However, Takimoto does not disclose the limitation of initially analyzing job attributes, and controlling job output as a response to this analysis. Even if Bauer does disclose a quota limitation, there is no motivation in the Bauer reference to show that Takimoto can be modified to initially analyze attributes of the requested job. Further, no evidence has been provided that the source of such motivation comes from knowledge generally available at the time, and known by a person of skill in the art. For these reasons, the Applicant respectfully submits that a case has not been made to support the assumption that there is motivation to modify known art in such a way as to make obvious the claimed invention, which is the first *prima facie* requirement.

Likewise, no case has been provided to support the second *prima facie* requirement, that there is a reasonable expectation of success in the claimed invention.

With respect to the third *prima facie* requirement, even if the references are combined, they do not disclose all the elements of the claimed invention. As noted above, neither Bauer nor Takimoto disclose a system that initially analyzes the attributes of a requested job, as defined in amended claims 1 and 13, and controls job output as a result of the analysis. Claim 7, dependent from claim 1, and claim 19, dependent from claim 13, include the same distinctions as the base claims, and the Applicant requests that the rejection be removed.

In Section 9 of the Office Action claims 8-9 and 20 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Takimoto in view of Salgado et al. ("Salgado"; US 6,112,039) and Lester et al. ("Lester";

US 7,072,065). The Office Action acknowledges that Takimoto fails to describe printer languages and front panel controls, but that the Salgado and Lester references disclose these features. This rejection is traversed as follows.

The Takimoto, Salgado, and Lester references have been combined on the assumption that Takimoto discloses all the limitations of claims 1 and 13. However, Takimoto does not disclose the limitation of initially analyzing job attributes, and controlling job output as a response to this analysis. Even if Salgado disclose printer languages and Lester discloses printer front panels, there is no motivation in the Salgado/Lester references to show that Takimoto can be modified to initially analyze attributes of the requested job. Further, no evidence has been provided that the source of such motivation comes from knowledge generally available at the time, and known by a person of skill in the art. For these reasons, the Applicant respectfully submits that a case has not been made to support the assumption that there is motivation to modify known art in such as way as to make obvious the claimed invention, which is the first *prima facie* requirement.

Likewise, no case has been provided to support the second *prima facie* requirement, that there is a reasonable expectation of success in the claimed invention.

With respect to the third *prima facie* requirement, even if the references are combined, they do not disclose all the elements of the claimed invention. As noted above, none of the Salgado, Lester, or Takimoto references discloses a system that initially analyzes the attributes of a requested job, as defined in amended claims 1 and 13, and controls job output as a result of the analysis. Claims 8-9, dependent from claim 1, and claim 20,

dependent from claim 13, include the same distinctions as the base claims, and the Applicant requests that the rejection be removed.

In Section 10 of the Office Action claims 12 and 24 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Takimoto in view of Lawson et al. ("Lawson"; US 6,829,639). The Office Action acknowledges that Takimoto fails to describe an administrator notice. This rejection is traversed as follows.

The Takimoto and Lawson references have been combined on the assumption that Takimoto discloses all the limitations of claims 1 and 13. However, Takimoto does not disclose the limitation of initially analyzing job attributes, and controlling job output as a response to this analysis. Even if Lawson does disclose a notice that is sent to an administrator in the event of improper user authority, there is no motivation in the Lawson reference to show that Takimoto can be modified to initially analyze attributes of the requested job. Further, no evidence has been provided that the source of such motivation comes from knowledge generally available at the time, and known by a person of skill in the art. For these reasons, the Applicant respectfully submits that a case has not been made to support the assumption that there is motivation to modify known art in such a way as to make obvious the claimed invention, which is the first *prima facie* requirement.

Likewise, no case has been provided to support the second *prima facie* requirement, that there is a reasonable expectation of success in the claimed invention.

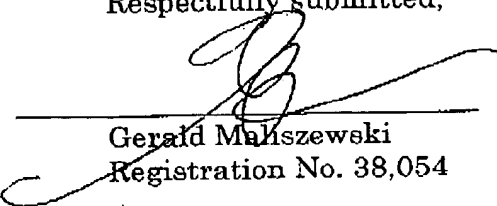
With respect to the third *prima facie* requirement, even if the references are combined, they do not disclose all the elements of the claimed invention. As noted above, neither Lawson nor Takimoto disclose a system that initially analyzes the attributes of a requested job, as defined in

amended claims 1 and 13, and controls job output as a result of the analysis. Claim 12, dependent from claim 1, and claim 24, dependent from claim 13, include the same distinctions as the base claims, and the Applicant requests that the rejection be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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